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U.S. Pat. Appl. Serial No.: 10/729,841
Responsive to Office Action of March 8, 2006REMARKS/ARGUMENTS

The Office Action of March 8, 2006 has been carefully reviewed and these remarks are responsive thereto. Claims 1-11, 19-40, 42-49, 51-56, 59-70, and 72-73 remain pending. Reconsideration and allowance of the instant application are respectfully requested.

Rejections Under 35 U.S.C. § 103

Claims 1-11, 19-40, 42-49, 51-56, 59-70, and 72-73 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Appl. Publ. No. US 2003/0225796 A1 to Matsubara (*Matsubara*) in view of U.S. Patent Appl. Publ. No. US 2004/0103280 A1 to Balfanz et al. (*Balfanz*). Applicants respectfully traverse this rejection for at least the following reasons.

Claim 1 recites, in part, "storing information, corresponding to the item to be shared and corresponding to the sharee, on the sharer's computer." The Office Action states that *Matsubara* does not teach or suggest this feature of claim 1, but alleges that *Balfanz* teaches "storing information, corresponding to the item to be shared and corresponding to the sharee, on the sharer's computer," at Fig. 5; sections [0007], [0019], [0024]-[0025], and [0030]-[0032]. Office Action, page 5, lines 3-7.

However, there is no motivation or suggestion to combine *Matsubara* with *Balfanz*. The Office Action states that it would have been obvious to combine the references because:

One having ordinary skill in the art would have found it motivated to utilize the use of a list of file sharing group having member on the sharable virtual directory over the network (*Balfanz's* sections 0024-0025), into the system of *Matsubara* *for the purpose of enabling pre-authorized devices to access and share those files securely* (*Balfanz's* section 0001).

Office Action, page 5, lines 10-14 (emphasis added). This is not a motivation to combine references, however, but rather is the conclusion the Examiner has apparently reached after having benefited from reading Applicants' own disclosure, and is thus impermissible hindsight. Thus, Applicants respectfully submit that there is no motivation or suggestion to combine *Matsubara*, which discloses a peer-to-peer file sharing system with a central server, with *Balfanz*, which discloses a group member list stored on each machine in the sharing system.

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In fact, *Balfanz* specifically teaches away from the use of a central server, which is the basis for *Matsubara*'s entire sharing system:

Another approach uses a central server, such as an FTP server, to allow clients to access and securely share documents stored on the server. But these servers can be single points of failure, and often require a high degree of administrative overhead to setup the security protocols. Worse yet, central servers may not even be available in ad-hoc distributed network environments. With the advent of devices and services that can communicate in a fluid, ad-hoc manner, a central server scheme is inadequate for sharing documents securely. (Emphasis added)

Balfanz, section [0004]. Thus, a major design goal of *Balfanz* is to avoid the use of a central server, which is critical to the peer-to-peer file sharing functionality supported by *Matsubara*.

Similarly, *Matsubara*, through the use of a central resource naming server (RNS server) attempts to achieve a "more scalable file storage method." *Matsubara*, section [0008]. However, the modification of *Matsubara* to add the group member lists and file lists of *Balfanz* at each sharee and sharer in the peer-to-peer sharing network, would apparently require all of the information in *Matsubara*'s RNS to be replicated to each individual machine in the system and constantly synchronized with the central RNS server. This constant data replication and synchronization would dramatically limit the performance and scalability of *Matsubara*'s peer-to-peer network, defeating one of the major design goals of *Matsubara*'s system.

Thus, Applicants submit that the combination of *Matsubara* and *Balfanz* was improper, and respectfully request withdrawal of the pending rejection under 35 U.S.C. § 103(a).

Further, irrespective of the above deficiencies in the Office Action, Applicants maintain that, even if *Matsubara* and *Balfanz* were improperly combined, the combination still would not have taught or suggested all the recitations of several pending claims.

For example, with respect to claims 3 and 4, Applicants reassert arguments put forth in the Amendment filed on July 8, 2005. Namely, *Matsubara* does not teach or suggest "verify[ing] that a file share exists from which the virtual folder item to be shared can be accessed remotely," as recited in claim 3, or "wherein if a file share already exists, the permissions on the file share are set so as to allow the sharee to access the item that is to be shared," as recited in claim 4. Indeed, the terms "file shares" or "shares" are not mentioned anywhere in *Matsubara*, nor is any equivalent concept. A "file share" on a computer network is

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a well-known term in the software arts, and is not taught or suggested simply by referring to an access control list, as alleged by the Office Action of September 20, 2005. Since *Balfanz* does not overcome this deficiency by disclosing a file share on a computer, claims 3 and 4 are not obvious over *Matsubara* and *Balfanz* for this additional reason.

Similarly, with respect to claim 7, Applicants reassert arguments put forth in the Amendment filed on July 8, 2005. Namely, *Matsubara*, which does not disclose a firewall, thus does not teach or suggest, "verifying that the sharer's firewall will allow the sharee to access the shared virtual folder item," as recited in claim 7. The responsive Office Action stated that "the features upon which the applicant relies (i.e., 'firewall') are not recited in the rejected claim(s)." Office Action of September 20, 2005, page 3. Clearly, the term "firewall" is recited in claim 7. Since *Balfanz* does not overcome this deficiency by disclosing a firewall, Applicants respectfully request withdrawal of the pending rejection of claim 7 for this additional reason.

Similarly, with respect to claims 56, 60, 62, 64, and 66, *Matsubara* does not describe sharing of "non-folder non-file items," as recited in these claims. Applicants note that this rejection was traversed in the Amendment filed on July 8, 2005, and that the responsive Office Action did not even attempt to rebut or otherwise address Applicants arguments in this regard. The most recent Office Action alleges that "*Matsubara* teaches wherein the item comprises a non-folder non-file item (electronic message such as e-mail: section 0066)." Office Action, page 16, line 21-22. However, the relied upon section of *Matsubara* does not contain the words "electronic message" or "e-mail." In fact, these terms are found nowhere in *Matsubara*, nor are several other terms which might relate to a non-folder non-file item, such as "contact," "appointment," or "non-file." Further, as argued previously by Applicants, it is not likely that the infrastructure described by *Matsubara* could support the sharing of these types of items. Non-file items do not reside within the physical file hierarchy of a computer, but are found in databases or data files associated with email programs, calendaring applications, etc. *Matsubara* creates and maintains a file table and a directory table in the server system, which store the location of the shared files. *Matsubara*, Figures 3 and 4. Since non-file items do not reside within the physical file system hierarchy of the computer, they would not have a VRL (virtual resource location) or other compatible format for storing the file location. *Matsubara*, paragraph 0051. Thus, *Matsubara* does not describe non-folder non-file items and, even if it provided

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some sort of suggestion, there is no expectation of success in modifying *Matsubara* to handle non-folder non-file items. Since *Balfanz* does not overcome this deficiency by disclosing sharing of non-folder non-file items, Applicants respectfully request withdrawal of the pending rejection of claims 56, 60, 62, 64, and 66 for this additional reason.

CONCLUSION

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 8 day of June, 2006

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